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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/725,294	11/29/2000	Masashi Koshino	11P338920	8772
21254	7590	02/07/2005	EXAMINER	
MCGINN & GIBB, PLLC 8321 OLD COURTHOUSE ROAD SUITE 200 VIENNA, VA 22182-3817			AMINZAY, SHAIMA Q	
			ART UNIT	PAPER NUMBER
			2684	

DATE MAILED: 02/07/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/725,294

Applicant(s)

KOSHINO, MASASHI

Examiner

Shaima Q. Aminzay

Art Unit

2684

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 September 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 3-5,9-11 and 13-18 is/are allowed.
- 6) ☒ Claim(s) 1,2,7,8,19 and 20 is/are rejected.
- 7) ☒ Claim(s) 6 and 12 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 20 November 2000 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Amendment

The following office action is in response to Amendment, filed on September 24, 2004.

The independent claims 1-5, 7-11, and 20 are currently amended.

Claims 1-20 are pending.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

1. Claims 1, 7, 19, and 20 are rejected under 35 U.S.C. 102(e) as being anticipated by Jokimies (Jokimies et al., US Patent No. 6,526,267).

Regarding claims 1 and 7, Jokimies teaches of a radio communication terminal system and method which during a waiting operation receives broadcast data from a plurality of base stations to determine a current presence position, said terminal (Figures 1, 3, and 4 and starting column 1, line 33 and ending

column 2, line 4), comprising:

a storing unit for storing broadcast data and reception levels received from said plurality of base stations, as registered data (Figure 3 and column 4, lines 38 – 46 and column 3, lines 4 – 24), when said radio communication terminal is located at a preset position and comparing means for comparing (Figures 2 and 3 and starting column 3, lines 26 – 44), and comparing means including a determining means for determining that at least one of a number of said base stations and a reception level from said base stations is changing frequency (see for example, column 3, lines 26 – 37), during said waiting operation, said broadcast data and said reception levels with said registered data in said storing unit (as seen in Figures 3 and 4 and column 4, lines 46 – 54 and column 3, lines 4–24).

Regarding claim 19, Jokimies teaches of a radio communication system (Figures 1, 3, and 4 and starting column 1, line 33 and ending column 2, line 4), comprising: a plurality of base stations (Figures 1, 3, and 4 and starting column 1, line 33 and ending column 2, line 4); and a radio communication terminal according to claim 1 (as noted above in the rejection for claim 1).

Regarding claim 20, Jokimies teaches of a method of radio communication (Figures 1, 3, and 4 and starting column 1, line 33 and ending column 2, line 4), comprising: comparing during a waiting operation, broadcast data and reception

levels from a plurality of base stations with registered data corresponding to a preset position (Figures 2 and 3 and starting column 3, lines 26 – 44 and starting column 3, line 66 and ending column 4, line 10), and wherein said comparing includes determining that at least one of a number of said base stations and a reception level from said base stations is changing frequently (see for example, column 3, lines 26 – 37).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action

(a) Patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made

2. Claims 2 and 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Jokimies (Jokimies et al., US Patent No. 6,526,267) in view of Kraft (Kraft et al., US Patent 6,463,278).

Regarding claims 2 and 8, Jokimies teaches of a radio communication terminal system and method which during a waiting operation receives broadcast data from a plurality of base stations (Figures 1, 3, and 4 and starting column 1, line 33 and ending column 2, line 4), comprising a storing unit for storing

broadcast data and reception levels received from said plurality of base stations, as registered data, when said radio communication terminal is in a preset presence located at a preset position and reception levels of these broadcast data as registered data (Figure 3 and column 4, lines 38 – 46 and column 3, lines 4 – 24), and comparing means for comparing (Figures 2 and 3 and starting column 3, lines 26 – 44), said comparing includes determining that at least one of a number of said base stations and a reception level from said base stations is changing frequently (see for example, column 3, lines 26 – 37), during said waiting operation, said broadcast data and said reception levels with said registered data in said storing unit (as seen in Figures 3 and 4 and column 4, lines 46 – 54 and column 3, lines 4 – 24).

Jokimies does not specifically teach of setting means for setting, when said comparing means detects coincidence between said broadcast data and said reception levels and said registered data, a preset function corresponding to the pertinent said registered data.

In a related art dealing with automatic telephone parameter selection, Kraft teaches of setting means for setting, when said comparing means detects coincidence between said broadcast data and said reception levels and said registered data, a preset function corresponding to the pertinent said registered data (column 1, lines 35 – 54 and Tables 1 –3).

It would have been obvious to one skilled in the art at the time of invention to have included into Jokimies' detection system, Kraft's automatic present function

provisions, for the purposes of automatically setting user preferences in accordance with different environments (i.e. meetings, car use, act.), as taught by Kraft.

Allowable Subject Matter

3. Claims 3-5, 9-11, and 13-18 are allowed.
4. Claims 6 and 12 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Response to Arguments

Applicant's arguments filed September 24, 2004 have been fully considered but they are not persuasive.

The applicant (middle to end of page 12) argued that the "reference fails to teach the method of constantly searching for current presence position during "waiting operations", meaning periods during which the radio communication terminal is not actively engaged in a current transmission event (e.g., waiting for a call)." The Examiner respectfully disagrees. The applicant's statement of

"constantly searching for current presence position during "waiting operations" is not part of the claimed limitation, however, Jokimies teaches consistently searching for current presence position while waiting operations.

The applicant (end of page 13) further argues that "Jokimies fails to teach or suggest the capability to detect and set the high speed travel mode, during which the number of the received base stations and/or the reception levels are changing rapidly", and further, argues (beginning of page 13) that Jokimies does not teach "comparing means including a determining means for determining that at least one of a number of said base stations and a reception level from said base stations is changing frequently..." The Examiner respectfully disagrees."

As discussed in the rejection above, Jokimies reception levels are changing rapidly, comparing and determining that at least one of a number of said base stations and a reception level from said base stations is changing frequently.

Rejection is maintained.

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Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Shaima Q. Aminzay whose telephone number is 703-305-8723. The examiner can normally be reached on 7:00 AM -5:00 PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nay Maung can be reached on 703-308-7745. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Shaima Q. Aminzay

(Examiner)

NICK CORSARO
PRIMARY EXAMINER_____
Nay Maung

(SPE)

Art Unit 2684

February 1, 2005